

Appellants' Reply Brief on Appeal
U.S. Application Serial No. 09/457,732
Docket No. YOR919990137US1
(YOR.080)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Andrea CALIFANO, et al.

Serial No.: 09/457,732

Group Art Unit: 2131

Filed: December 10, 1999

Examiner: La Forgia, Christian A.

For: SEMIOTIC SYSTEM AND METHOD WITH PRIVACY PROTECTION

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated January 17, 2008. Entry of this Reply Brief is respectfully requested.

I. STATUS OF CLAIMS

Claims 1, 5-9, and 11-36 are all the claims presently pending in the application, and are set forth fully in the attached Appendix. Claims 1, 5, 9, 15, 17, 19, 24, 27, 29, 31, 33,

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and 35 are independent claims. Claims 6-8, 11-14, 16, 18, 20-23, 25, 26, 28, 30, 32, 34, and 36 are dependent claims.

Claims 2-4 and 10 stand canceled.

Claims 1, 14-16, 31, and 32 stand rejected under 35 U.S.C. § 101 as allegedly being inoperative and lacking utility.

Claims 31-36 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 1, 5-9, and 11-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borza (U.S. Patent No. 6,446,210) in view of Kharon, et al. (U.S. Patent No. 6,487,662; hereinafter “Kharon”).

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

As set forth in the Appeal Brief, the issues presented for review by the Board of Patent Appeals and Interferences are whether Claims 1, 14-16, 31, and 32 stand rejected under 35 U.S.C. § 101 for lack of utility, Claims 31-36 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter, and Claims 1 and 5-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borza in view of Kharon.

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III. ARGUMENT

In the Examiner's Amendment, the Examiner maintained each rejection on Appeal. Furthermore, the Examiner provided a Response to Argument in response to the Appeal Brief filed on November 26, 2007.

Appellants stand by the arguments in the Argument section of the Appeal Brief as supplemented by Appellants' below response to the Examiner's Response to Arguments.

Response to Examiner Arguments

The following comments are provided in the same order as presented by the Examiner in the Examiner's Response to Arguments on pages 12-19 of the Examiner's Answer. Appellants have not addressed all of the Examiner's comments in the Response to Arguments on pages 12-19 of the Examiner's Answer. Appellants have only provided further comments to issues not completely addressed in the Appeal Brief filed on November 26, 2007.

35 U.S.C. § 101 – Non-Statutory

First of all, it is noted that claim 31 (and similarly claims 32-36) states: "A computer-readable signal-bearing medium tangibly embodying a program of recordable, machine-

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readable instructions executable by a digital processing apparatus to perform a method for computer-implemented processing biometric data....”

As such, because of the wording “tangibly embodying”, this description clearly addresses at least the computer-readable media that are physically embodied, including at least memory embodiments on a computer, such as a hard drive or RAM, that are storing the program either for actually executing the method of the program or for storing the program for potentially execution at some future time. Likewise, this wording also covers the tangible embodiments of a standalone diskette, such as a floppy or CD, as based upon *In re Beauregard*, 53 F.3d 1583 (Fed Cir, 1995), and subsequently-issued US Patent No. 5,710,578 that issued on January 20, 1998, to Beauregard et al.

The Examiner’s position seems to be based upon the possibility that the claim language additionally covers the transmission of the computer program, which the Examiner declares to be non-statutory subject matter.

In response, Appellants respectfully submit that neither Appellants nor Appellants’ representative knows yet whether transmission of patented methods are protected against transmission via, for example, the Internet or wireless transmission, simply because this issue has never been resolved in the Courts. In the interim, it is up to the Courts and Congress to make up new law, not the Examiner or the USPTO.

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Second, it is brought to the Examiner's attention that the plain language of the claim is not claiming "transmission media", as alleged in the rejection. Rather, as pointed out above, the claim preamble actually reads: "*A computer-readable signal-bearing medium tangibly embodying a program of recordable, machine-readable instructions executable by a digital processing apparatus to perform a method for computer-implemented processing biometric data....*"

Accordingly, Appellants respectfully submit that, to the extent this wording is construed as being related to a transmission of the program, as the Examiner seems to do for this rejection, the plain meaning of the language would require a computer-readable medium tangibly embodying the program of machine-readable instructions, for purpose of determining infringement. Whether or not the transmission process by itself is sufficient to establish statutory subject matter is still unknown, but it is clear that, if a tangible medium results from the transmission, then a cause for infringement clearly would exist.

Third, Appellants submit that the wording of the claim is directed to a "program of machine-readable instructions" and, as such, are directed to a process, one of the four categories specifically identified in 35 USC §101 as statutory subject matter.

Therefore, Appellants respectfully submit that this claim does indeed address statutory subject matter and, to the extent that it is considered to be related to a transmission

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of some sort, the plain meaning of the claim language precludes the interpretation that the Examiner has alleged.

Attacking References Individually

In the Response to Arguments the Examiner alleges that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*” (see Examiner’s Answer dated January 17, 2008 at page 19).

Appellants point out that the Examiner has erroneously applied the decision of *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). That is, the facts presented in *In re Keller* clearly do not apply to Appellants’ arguments.

In *In re Keller*, the appellant provided an affidavit that was only concerned with whether one of the applied references suggested the use of digital timing in a cardiac pacer. That is, appellant only argued against one of the references, but did not provide any evidence that the other two references used in the 103(a) rejection did not teach or suggest digital timing in a cardiac pacer. The court stated that “the test is not whether a suggestion to use digital timing in a cardiac pacer is found in Walsh (which was the test applied by Dr. Cywinski), but rather what Keller in view of Walsh and what Berkovits in view of Walsh

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would have suggested to one of ordinary skill in the art". Therefore, in *In re Keller*, the appellant only attacked one of the applied references.

However, in stark contrast to the facts of *In re Keller*, in the Appeal Brief filed on December 19, 2005 (and the preceding Amendments), Appellants clearly provided arguments against each of the references (and their alleged combination) applied in the Examiner's 103(a) rejections. Appellants submit that Appellants' arguments provided in the Appeal Brief (and the preceding Amendments) are completely different from the facts of *In re Keller*.

IV. CONCLUSION

For the above reasons, as well as the reasons set forth in the Appeal Brief, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

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Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: March 17, 2008



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 48150